UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,108	07/24/2003	Brent L. Davis	BOC9-2003-0006 (375)	8969

			EXAMINER
40987	7590	08/11/2005	GAUTHIER, GERALD

AKERMAN SENTERFITT
P. O. BOX 3188
WEST PALM BEACH, FL 33402-3188

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/626,108	DAVIS ET AL.
	Examiner	**Art Unit**	
	Gerald Gauthier	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 April 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-17</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-17</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>01 April 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   **Claim(s) 3**, line 2 "caller" should be "callee". Correction is required.

2.   **Claim(s) 8-10** is objected to because of the following informalities: line 1 "claim

8" should be "claim 7". Correction is required.

Claim(s) 9, line 1 and **claim(s)** 10, line 1 have the same problem.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

4.   **Claim(s) 7, 9, 10, 14, 15 and 17** are rejected under 35 U.S.C. 102(e) as being

anticipated by Whynot et al. (US 2004/0267531 A1).

Regarding **claim(s) 7**, Whynot discloses a method to enable instant collaboration

(FIG. 1 and paragraph 0001), comprising the steps of:

receiving a text message having a designation for text-to-speech conversion via

an instant messaging server, wherein the text message is intended for a phone coupled

to a voicemail system (FIG. 3 and paragraph 0036) [The media application server 104

receives a convertible instant message for a recipient' s communication device 108

which is attached to a messaging system from a sender' s text communication device

106];

recognizing the designation (FIG. 3 and paragraph 0036) [The convertible instant

message includes a telephone number for the recipient];

converting the text message to a voice message (FIG. 3 and paragraph 0041)

[The text-to-speech converter 120 converts the convertible instant message from text to

speech];

calling the phone (FIG. 3 and paragraph 0036) [The media application server 104

contacts the recipient by placing a call to the recipient' s speech communication device

108]; and

delivering the voice message to the voicemail system (FIG. 3 and paragraph

0043) [The media application server 104 provides the converted instant message to a

voice mail when the recipient is unavailable to hear the message].

Regarding **claim(s) 9**, Whynot discloses a method wherein the method further

comprises the step of delivering the voice message to a user (FIG. 3 and paragraph

0043) [The media application server 104 provides the converted instant message to a

voice mail when the recipient is unavailable to hear the message].

Regarding **claim(s) 10**, Whynot discloses a method, wherein the method further comprises the step of delivering the voice message to the voicemail system (FIG. 3 and paragraph 0043) [The media application server 104 provides the converted instant message to a voice mail when the recipient is unavailable to hear the message].

Regarding **claim(s) 14**, Whynot discloses a system enabling instant collaboration (FIG. 1 and paragraph 0001), comprising:

a voicemail system (FIG. 1 and paragraph 0043) [The media application server 104 provide the audio stream to a messaging system such as voice mail];

an instant messaging system coupled to the voicemail system (FIG. 1 and paragraph 0043) [The media application server 104 provide the audio stream to a messaging system such as voice mail, thereby an instant messaging system coupled to the voicemail system];

a processor (FIG. 2 and paragraph 0026) in the system programmed to:

receive a text message having a designation for text-to-speech conversion via the instant messaging system, wherein the text message is intended for a phone coupled to the voicemail system (FIG. 3 and paragraph 0036) [The media application server 104 receives a convertible instant message for a recipient' s communication device 108 which is attached to a messaging system from a sender' s text communication device 106];

recognize the designation (FIG. 3 and paragraph 0036) [The convertible instant message includes a telephone number for the recipient];

convert the text message to a voice message (FIG. 3 and paragraph 0041) [The

text-to-speech converter 120 converts the convertible instant message from text to

speech];

call the phone (FIG. 3 and paragraph 0036) [The media application server 104

contacts the recipient by placing a call to the recipient' s speech communication device

108];

deliver the voice message to the voicemail system (FIG. 3 and paragraph 0043)

[The media application server 104 provides the converted instant message to a voice

mail when the recipient is unavailable to hear the message].

Regarding **claim(s) 15**, Whynot discloses a system, wherein the processor

resides within the voicemail system (FIG. 2 and paragraph 0026).

Regarding **claim(s) 17**, Whynot discloses a machine-readable storage, having

stored thereon a computer program having a plurality of code sections executable by a

machine (FIG. 1 and paragraph 0001 and 0018) for causing the machine to perform the

steps of:

receiving a text message having a designation for text-to-speech conversion via

an instant messaging server, wherein the text message is intended for a phone coupled

to a voicemail system (FIG. 3 and paragraph 0036) [The media application server 104

receives a convertible instant message for a recipient' s communication device 108

which is attached to a messaging system from a sender' s text communication device

106];

recognizing the designation (FIG. 3 and paragraph 0036) [The convertible instant

message includes a telephone number for the recipient];

converting the text message to a voice message (FIG. 3 and paragraph 0041)

[The text-to-speech converter 120 converts the convertible instant message from text to

speech];

calling the phone (FIG. 3 and paragraph 0036) [The media application server 104

contacts the recipient by placing a call to the recipient' s speech communication device

108];

delivering the voice message to the voicemail system (FIG. 3 and paragraph

0043) [The media application server 104 provides the converted instant message to a

voice mail when the recipient is unavailable to hear the message].

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1.   Determining the scope and contents of the prior art.
    2.   Ascertaining the differences between the prior art and the claims at issue.
    3.   Resolving the level of ordinary skill in the pertinent art.
    4.   Considering objective evidence present in the application indicating
            obviousness or nonobviousness.

7.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

8.   **Claim(s) 1-3, 11, 13 and 16** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Adamczyk (US 2004/0151284) in view of Hanson et al (US 6,697,474

B1).

        Regarding **claim(s) 1**, Adamczyk discloses a method to enable instant

collaboration via the use of pervasive messaging (FIG. 2 and paragraph 0002),

comprising the steps of:

        receiving a call from a caller to a callee (FIG. 2 and paragraph 0066) [The central

office 308 receives a call from a sending subscriber 310 for a receiving subscriber 320];

        transferring the call to a voicemail system when the callee is unavailable (FIG. 3

and paragraph 0066) [The call is transferred to the VMS 306, 316 when the receiving

subscriber cannot answer the call]; and

        querying the caller if they want to leave one among a voice message and an

instant message (FIG. 3 and paragraph 0066) [The VMS 306, 316 provides the

subscriber an option to leave a conventional voice message or to transmit an instant

message to the other subscriber].

        Although, Adamczyk disclose an instant message server to allow the subscriber

receiving an instant message but fails to disclose determining if the callee is available

via instant messaging.

        However, Hanson in the same field of endeavor teaches a method that

determines if the callee is available via instant messaging (FIGS. 7-9 and column 8,

lines 57-63) [The ACP 125 queries the database to determine if the user is currently on

line for an instant messaging service].

Therefore, it would have been obvious to one of the ordinary skill in the art at the

time the invention was made to modify the invention of Adamczyk using the automated

call processor as taught by Hanson.

This modification of the invention enables the system to determine if the callee is

available via instant messaging so that the user would receive a telephone call via its

instant messaging client (Hanson: column 2, lines 1-6).

Regarding **claim(s) 2**, Adamczyk discloses a method wherein the method further

comprises the step of recording a voice message from the caller to the callee and

transcribing the voice message to a text message when the caller selected the instant

message as an option (paragraphs 0052 and 0053) [The VMS 306 includes a processor

that convert a receive voice mail message to a text message when the sender selects

the instant message option].

Regarding **claim(s) 3**, Adamczyk discloses a method, wherein the method

further comprises the step of sending the text message to the callee via the instant

messaging system (paragraphs 0054) [The extended messaging directory determine

the address of a recipient to send the message using the instant messaging platform].

Regarding **claim(s) 11**, Adamczyk discloses a system enabling instant

collaboration (FIG. 2 and paragraph 0002), comprising:

a voicemail system (VMS 316 on FIG. 2);

an instant messaging system (334 on FIG. 2) coupled to the voicemail system

(FIG. 2 and paragraph 0071) [The VMS 316 is coupled to the instant messaging

platform 334 via the Internet];

a processor (316b on FIG. 2) in the system programmed to:

receive a call when a callee is unavailable (FIG. 3 and paragraph 0066) [The

VMS 306, 316 receives a call from a sending subscriber to a receiving subscriber when

the receiving subscriber cannot answer the call]; and

provide a caller the option among a voice message and an instant message

(FIG. 3 and paragraph 0066) [The VMS 306, 316 provides the subscriber an option to

leave a conventional voice message or to transmit an instant message to the other

subscriber].

Although, Adamczyk disclose an instant message server to allow the subscriber

receiving an instant message but fails to disclose determining if the callee is available

via instant messaging.

However, Hanson in the same field of endeavor teaches a method that

determines if the callee is available via instant messaging (FIGS. 7-9 and column 8,

lines 57-63) [The ACP 125 queries the database to determine if the user is currently on

line for an instant messaging service].

Therefore, it would have been obvious to one of the ordinary skill in the art at the

time the invention was made to modify the invention of Adamczyk using the automated

call processor as taught by Hanson.

This modification of the invention enables the system to determine if the callee is

available via instant messaging so that the user would receive a telephone call via its

instant messaging client (Hanson: column 2, lines 1-6).

Regarding **claim(s) 13**, Adamczyk discloses a system wherein the processor

resides within the voicemail system (FIG. 2 and paragraph 0053).

Regarding **claim(s) 16**, Adamczyk discloses a machine-readable storage, having

stored thereon a computer program having a plurality of code sections executable by a

machine (FIG. 2 and paragraphs 0002 and 0053) [The VMS includes a processor runs

by software stored in the computer hard drive allowing the system to execute different

tasks] for causing the machine to perform the steps of:

receiving a call from a caller to a callee (FIG. 2 and paragraph 0066) [The central

office 308 receives a call from a sending subscriber 310 for a receiving subscriber 320];

transferring the call to a voicemail system when the callee is unavailable (FIG. 3

and paragraph 0066) [The call is transferred to the VMS 306, 316 when the receiving

subscriber cannot answer the call]; and

querying the caller if they want to leave one among a voice message and an

instant message (FIG. 3 and paragraph 0066) [The VMS 306, 316 provides the

subscriber an option to leave a conventional voice message or to transmit an instant

message to the other subscriber].

Although, Adamczyk disclose an instant message server to allow the subscriber

receiving an instant message but fails to disclose determining if the callee is available

via instant messaging.

However, Hanson in the same field of endeavor teaches a method that

determines if the callee is available via instant messaging (FIGS. 7-9 and column 8,

lines 57-63) [The ACP 125 queries the database to determine if the user is currently on

line for an instant messaging service].

Therefore, it would have been obvious to one of the ordinary skill in the art at the

time the invention was made to modify the invention of Adamczyk using the automated

call processor as taught by Hanson.

This modification of the invention enables the system to determine if the callee is

available via instant messaging so that the user would receive a telephone call via its

instant messaging client (Hanson: column 2, lines 1-6).

9.   **Claim(s) 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over

Adamczyk in view of Hanson as applied to **claim(s) 1 and 2** above, and further in view

of Khakoo et al (US 2003/0135569 A1).

Regarding **claim(s) 4**, Adamczyk in combination with Hanson as applied to

claim(s) 2 above differ from **claim(s) 4**, in that it fails to disclose translating the text

message to provide a translated text message and sending the translated text message

to the callee via the instant messaging system.

However, Khakoo, in the same field of endeavor, teaches a method, wherein the

method further comprises the step of translating the text message to provide a

translated text message and sending the translated text message to the callee via the

instant messaging system (paragraph 0018) [The instant message delivery server 100

perform language translation of the text message to be sent to the recipient].

Therefore, it would have been obvious to one of the ordinary skill in the art at the

time the invention was made to modify the invention of Adamczyk in combination with

Hanson using the instant message delivery server as taught by Khakoo.

This modification of the invention enables the system to translate the text

message and send the translated text message to the callee via the instant messaging

system so that the user would have the benefit of receiving the message in the

preferred human language (Khakoo: paragraph 0018).

10.   **Claim(s) 5, 6 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Adamczyk in view of Hanson as applied to **claim(s) 1 and 11** above, and further in

view of Washburn (US 2004/0186889 A1).

Regarding **claim(s) 5**, Adamczyk in combination with Hanson as applied to

claim(s) 1 above differ from **claim(s) 5**, in that it fails to disclose querying the caller as

to when an instant message should be delivered when the caller selected the instant

message as an option.

However, Washburn, in the same field of endeavor, teaches a method, wherein

the method further comprises the step of querying the caller as to when an instant

message should be delivered when the caller selected the instant message as an option

(FIG. 3 and paragraph 0047) [The message sender can schedule to have the message

delivered at a specific date and time].

Therefore, it would have been obvious to one of the ordinary skill in the art at the

time the invention was made to modify the invention of Adamczyk in combination with

Hanson using the message template as taught by Washburn.

This modification of the invention enables the system to query the caller as to

when an instant message should be delivered so that the user would have the benefit at

a predetermined time to receive information regarding a stock quote (Washburn:

paragraph 0007).

Regarding **claim(s) 6**, Adamczyk in combination with Hanson as applied to

claim(s) 1 above differ from **claim(s) 6**, in that it fails to disclose delivering the instant

message to the callee at a predetermined scheduled time as directed by the caller.

However, Washburn, in the same field of endeavor, teaches a method, wherein

the method further comprises the step of delivering the instant message to the callee at

a predetermined scheduled time as directed by the caller (FIG. 3 and paragraph 0049) [The message is delivered to the recipient on the date and time as specified by the caller].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk in combination with Hanson using the message template as taught by Washburn.

This modification of the invention enables the system to deliver the instant message to the callee at a predetermined scheduled time as directed by the caller so that the user would have the benefit at a predetermined time to receive information regarding a stock quote (Washburn: paragraph 0007).

Regarding **claim(s) 12**, Adamczyk in combination with Hanson as applied to **claim(s) 1** above differ from **claim(s) 12**, in that it fails to disclose the processor is further programmed to deliver the instant message to the callee at a predetermined scheduled time as directed by a caller.

However, Washburn, in the same field of endeavor, teaches a system, wherein the processor is further programmed to deliver the instant message to the callee at a predetermined scheduled time as directed by a caller (FIG. 3 and paragraph 0049) [The message is delivered to the recipient on the date and time as specified by the caller].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk in combination with Hanson using the message template as taught by Washburn.

This modification of the invention enables the system to have the processor is further programmed to deliver the instant message to the callee at a predetermined scheduled time as directed by a caller so that the user would have the benefit at a predetermined time to receive information regarding a stock quote (Washburn: paragraph 0007).

11.   **Claim(s) 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Whynot in view of Washburn.

Regarding **claim(s) 8**, Whynot as applied to **claim(s) 7** above differs from **claim(s) 8**, in that it fails to disclose enabling a scheduled delivery of the voice message to a user.

However, Washburn, in the same field of endeavor, teaches a method, wherein the method further comprises the step of enabling a scheduled delivery of the voice message to a user (FIG. 3 and paragraph 0047) [The message sender can schedule to have the message delivered at a specific date and time].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Whynot using the message template as taught by Washburn.

This modification of the invention enables the system to enable a scheduled delivery of the voice message to a user so that the user would have the benefit at a
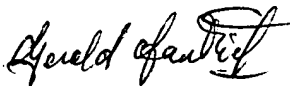
predetermined time to receive information regarding a stock quote (Washburn:

paragraph 0007).

Conclusion

12.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-

7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

Gerald Gauthier
Examiner
Art Unit 2645

g.g.
August 8, 2005